

07-01-2002

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #58

M&G 340.588-US-TB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Andersen Corporation,)
)
Opposer,)
)
v.)
)
The Flecto Company, Inc.,)
)
Applicant.)
_____)

Opposition No.: _____

Mark: **RENEWAL NO-SANDING
FORMULA**

Serial No.: 75/857,814

Filing Date: November 26, 1999

Published: January 1, 2002

NOTICE OF OPPOSITION

Andersen Corporation, a Minnesota corporation doing business at 100 Fourth Avenue North, Bayport, Minnesota, 55003-1096, believes that it will be damaged by registration of the mark RENEWAL NO-SANDING FORMULA shown in trademark application Serial No. 75/857,814, filed November 26, 1999, by The Flecto Company, Inc., published in the *Official Gazette* on January 1, 2002, and hereby opposes the same. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant seeks to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark RENEWAL NO-SANDING FORMULA as a trademark for "chemical abrasive for preparing wood floors for restoration," in International Class 3.

2. Opposer is in the business of manufacturing and selling windows, doors, and commercial and residential building materials. Opposer owns trademark rights in the marks RENEWAL BY ANDERSEN, and RENEWAL BY ANDERSEN and Design (collectively referred to herein as Opposer's "RENEWAL Marks" unless indicated otherwise).

3. Opposer is the owner of the mark RENEWAL BY ANDERSEN, having adopted and used said mark on or in connection with window installation services and retail store services featuring windows, doors and replacement windows and in the marketing and sale thereof in interstate commerce since at least as early as July 18, 1995.

4. Opposer duly registered RENEWAL BY ANDERSEN as a trademark for installation of windows in International Class 37 and retail store services featuring windows, doors and replacement windows in International Class 42 in the United States Patent and Trademark Office. Registration No. 2,077,925, issued July 8, 1997, based on an application filed May 18, 1995. Registration No. 2,077,925 has not been canceled, is valid, and is now in full force and effect.

5. Opposer is the owner of the mark RENEWAL BY ANDERSEN and Design, having adopted and used said mark on or in connection with retail store services featuring windows and doors, and installation of windows and doors, and in the marketing and sale thereof in interstate commerce since at least as early as March 1997.

6. Opposer duly registered RENEWAL BY ANDERSEN and Design as a trademark for retail store services featuring windows and doors in International Class 35 and installation of windows and doors in International Class 37 in the United States Patent and Trademark Office. Registration No. 2,338,186, issued April 4, 2000, based on an application filed March 16, 1999. Registration No. 2,338,186 has not been canceled, is valid, and is now in full force and effect.

7. Opposer is the owner of the mark RENEWAL BY ANDERSEN, having adopted and used said mark on or in connection with non-metal windows and component parts thereof distributed in interstate commerce since at least as early as June 1998.

8. Opposer duly registered RENEWAL BY ANDERSEN as a trademark for non-metal windows and component parts thereof in International Class 19 in the United States Patent and Trademark Office. Registration No. 2,332,422, issued March 21, 2000, based on an application filed April 9, 1999. Registration No. 2,332,422 has not been canceled, is valid, and is now in full force and effect.

9. Opposer is the owner of the mark RENEWAL BY ANDERSEN and Design, having adopted and used said mark on or in connection with non-metal windows, retail store services featuring windows, doors and replacement windows, and installation of windows distributed in interstate commerce since at least as early as February 1998 with respect to the retail store services and installation services, and June 1998 with respect to the non-metal windows.

10. Opposer duly registered RENEWAL BY ANDERSEN and Design as a trademark for non-metal windows in International Class 19, retail store services featuring windows, doors and replacement windows in International Class 35, and installation of windows in International Class 37 in the United States Patent and Trademark Office. Registration No. 2,243,149, issued May 4, 1999, based on an application filed September 25, 1996. Registration No. 2,243,149 has not been canceled, is valid, and is now in full force and effect.

11. Opposer has advertised and promoted its RENEWAL Marks extensively. Opposer has also made substantial sales of products under said marks. As a result of such use and promotion, Opposer's RENEWAL Marks have developed and represent valuable goodwill inuring to the benefit of Opposer. Further, Opposer's RENEWAL Marks are famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and became famous before Applicant commenced use of Applicant's RENEWAL NO-SANDING FORMULA mark.

12. Applicant's trademark application for RENEWAL NO-SANDING FORMULA is based on Applicant's intent to use this mark. Upon information and belief, Applicant has not commenced use of the RENEWAL NO-SANDING FORMULA mark.

13. Opposer adopted and commenced use of the term RENEWAL BY ANDERSEN as a trademark long before Applicant adopted the RENEWAL NO-SANDING FORMULA mark. Opposer's usage of the RENEWAL Marks commenced at least as early as 1995, more than 4 years prior to Applicant's filing date of its application. Opposer's earliest registration issued over 2 years prior to the filing date of Applicant's application. Opposer's later registrations also have priority over Applicant's application due to filing dates that proceed Applicant's filing date.

14. Applicant's RENEWAL NO-SANDING FORMULA mark is confusingly and deceptively similar to Opposer's previously used RENEWAL Marks.

15. The goods and services sold by Opposer under its RENEWAL Marks are closely related to the goods listed in Applicant's application for registration of the RENEWAL NO-SANDING FORMULA mark. Both parties' products are used in the home remodeling and restoration field. Opposer's RENEWAL stores and products are directed in large part to individuals and contractors involved in residential home remodeling, restoration and maintenance. Upon information and belief, Applicant's products are also directed to this market. It is quite likely that the same customers would purchase and utilize both Opposer's RENEWAL products and services in connection with their windows and doors, and Applicant's RENEWAL products in connection with their floors.

16. Upon information and belief, Opposer's and Applicant's products are promoted and sold in similar channels of trade to the same consumers or class of consumers. Upon

information and belief, Applicant's products are promoted and sold to residential consumers, the same group of consumers to whom Opposer's products are promoted and sold.

17. Applicant disclaimed the term "NO-SANDING FORMULA" apart from the mark as shown. The dominant part of Applicant's Mark is the term "RENEWAL." Taking the disclaimer into account, the mark proposed for registration by Applicant, RENEWAL NO-SANDING FORMULA, is similar in appearance, sound, connotation and commercial impression to Opposer's RENEWAL Marks.

18. Due to the similarity between Applicant's claimed mark, RENEWAL NO-SANDING FORMULA, and Opposer's previously used RENEWAL Marks, the related nature of the goods and services of the respective parties, customers and potential customers are likely to believe that Applicant's products originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

19. The use and registration by Applicant of the mark RENEWAL NO-SANDING FORMULA for Applicant's goods is likely to cause confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Opposer's previously used marks RENEWAL Marks, again resulting in damage to Opposer.

20. Because of the related nature of the goods, and the similarity of the marks, use and registration of the term RENEWAL NO-SANDING FORMULA by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer for use with Opposer's products causing further damage to Opposer.

21. Applicant's use and registration of the RENEWAL NO-SANDING FORMULA mark is likely to dilute the distinctive quality of Opposer's famous RENEWAL Marks, again resulting in damage to Opposer.

22. If Applicant is granted registration of the mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer.

23. Registration of the mark shown in Application Serial No. 75/857,814 will result in damage to Opposer under the provisions of Section 2(a), 2(d) and 2(f) of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that registration of the term RENEWAL NO-SANDING FORMULA for the goods set forth therein be refused.

Please direct all correspondence to:

Scott W. Johnston
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-9944

Opposer herein appoints Paul A. Welter, Reg. No. 20,890; D. Randall King; John A. Clifford, Reg. No. 30,247; Linda M. Byrne, Reg. No. 32,404; John L. Beard, Reg. No. 27,612; Brent E. Routman; Sandra Epp-Ryan, Reg. No. 39,667; Scott W. Johnston, Reg. No. 39,721; Kristina M. Foudray, Anna W. Manville and Gregory C. Golla of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Accompanying the duplicate signed copies of this Notice of Opposition is the required fee of \$300.00. Please charge any excess fees for or credit any overpayment to the Deposit Account No. 13-2725 of Opposer's counsel noted below.

Respectfully submitted,

ANDERSEN CORPORATION


By its Attorney,

Date: 6-28-02


Scott W. Johnston
MERCHANT & GOULD P.C.
80 South Eighth Street, Suite 3200
Minneapolis, Minnesota 55402-2215
(612) 332-5300

CERTIFICATE OF MAILING

The undersigned hereby certifies that the foregoing NOTICE OF OPPOSITION, regarding U.S. Serial Number 75/857,814, is being deposited with the U.S. Postal Service by First Class Mail, in an envelope addressed to the Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3513 on this 28th day of June, 2002.


Scott W. Johnston

Merchant & Gould

An Intellectual Property Law Firm

P.O. Box 2910
Minneapolis, Minnesota
55402-0910
TEL 612.332.5300
FAX 612.332.9081
www.merchant-gould.com



Direct Contact | 612.371.5274
sjohnston@merchant-gould.com

07-01-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #58

A Professional Corporation

Andersen Corporation,
Opposer,

v.
The Fleeto Company, Inc.,
Applicant.

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) Opposition No. _____
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Mark: RENEWAL NO-SANDING FORMULA
Serial No.: 75/857,814
Docket Number: 340.588USTB
Official Gazette: January 1, 2002

Due Date: June 30, 2002
Filing Date: November 26, 1999

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, on June 28, 2002.

By: 
Name: Scott W. Johnston

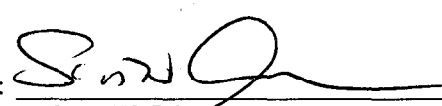
Commissioner for Trademarks
Box TTAB FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Commissioner:

We are transmitting herewith the attached:

- ☒ Return postcard.
- ☒ Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R. 1.8
- ☒ Notice of Opposition (1 Original and 1 Copy)
- ☒ Check in the amount of \$300.00 to cover Filing Fee.

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

By: 
Name: Scott W. Johnston
Reg. No.: 39,721
SWJ/skl

(CONTESTED MATTER)

TRADEMARK TRIAL AND
APPEAL BOARD
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